

The Restriction and our traverse. The Office Action divides the subject matter of 16 of the 33 claims into seventeen groups. That restriction is believed to be defective for the following reasons.

(1) In the first place, under 35 U.S.C. § 121, restriction is not required, but is discretionary:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. [emphasis added]

Moreover, 37 CFR 1.141 explicitly permits the inclusion of different claims to multiple species of an invention, provided that, as here, the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form or otherwise include all the limitations of the generic claim. A direct application of those provisions would at the least exempt claims 1 – 26 and claims 27 – 33, respectively, from restriction. Dividing them into 17 groups is inconsistent with 37 CFR 1.141.

(2) Furthermore, the Restriction is inconsistent with the PTO's goal of compact and efficient prosecution. Note that subsets of the seventeen groups share the same class and subclasses, indicating no additional search burden would be created if the respective groups were recombined.

(3) Despite the division of the subject matter into seventeen pieces, the restriction is still incomplete—it does not encompass all of applicants' claimed invention. What if applicants wished to elect the subject matter of any of claims 6 – 13? That election would be impossible since those claims are not within any of the designated groups for possible election. Since the electable groups designated by the Examiner do not encompass all of applicants' claimed invention, the restriction cannot be proper.

(4) The proposed division confounds prosecution by dispersing non-mutually-exclusive elements in two or more overlapping groups. For instance, the subject matter of group XII can also be covered by a number of Groups I – XI.

(5) With respect to the Examiner's comments on page 2 of the Restriction Requirement, we acknowledge that claim 1 is generic to in vivo and ex vivo approaches. However, we do not follow the thread of the argument presented there. For instance, in our copy of the application we do not

have a paragraph bridging pages 6 and 7, referenced by the Examiner. Moreover, if the Examiner was referring to the definition on page 6 of "genetically engineered cells", that definition is generic to cells whether in vivo or ex vivo. The definitions and claims are all consistent with the phrase "genetically engineering primates" meaning by the introduction of DNA or cells containing the DNA into the primates.

Provisional election. For the foregoing reasons we respectfully request reconsideration and withdrawal of the restriction requirement. However, for the sake of a complete response, applicants provisionally elect Group II, with traverse.

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Applicants thus respectfully traverse the restriction requirement and do so with provisional election of a group in order that this response be deemed complete. However, in the event that the restriction or species election requirement is withdrawn or redrafted, applicants reserve the right to make different elections consistent with those changed circumstances.

We do appreciate the Examiner's time and thought spent at this early stage and look forward to working with the Examiner during the ensuing prosecution of this important case. If it might be helpful in answering any questions or otherwise advancing prosecution, applicants earnestly invite the Examiner to call their attorney at the number provided below.

Respectfully submitted,

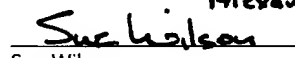


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